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EXAMINER
EGAN, BRIAN P

ART UNIT PAPER NUMBER

1772

DATE MAILED: 11/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

CLO 8

Office Action Summary

Application No.

10/037,587

Applicant(s)

MOTOMIYA, SEIYA

Examiner

Brian P. Egan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☒ None of:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Interpretation

1. Claims 6, 8, and 23-25 all contain optional phraseology that is given little to no patentable weight by the Examiner. Claiming an article that is “adapted to” function “when” a specific event occurs, i.e., when the release sheet is peeled off, fails to positively define the invention. “When” implies a future act that may or may not occur. Since the transferability of the printed layer is argued by the Applicant to be a patentable feature, the limitations must be positively defined to be given patentable weight. The Examiner suggests rewording the claim language such that the thermo-melting resin “is releasably adhered onto the releasing agent layer” and “is transferable to a pressure sensitive adhesive layer” whereby the thermal transfer printed layer is reliably peeled off from the releasing agent layer and transferred to the pressure sensitive adhesive layer when the release sheet is peeled off from the pressure sensitive adhesive label to positively define the releasable and transferable properties of the printed layer.

Claim Objections

2. Claim 13 is objected to for minor informalities. The claim comprises language in the past tense, i.e., “wherein the printed layer has been peeled off from the releasing agent layer and then transferred....” The limitation must be positively defined in the present tense. The Examiner suggests replacing the aforementioned phrase with “wherein the printed layer is peeled off from the releasing agent layer and is transferred to the pressure sensitive adhesive layer...” to facilitate clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. The phrase "such as," i.e., such as pigment or dye, is indefinite. The Examiner suggests replacing "such as" with "including one of a pigment or dye" as defined in the other independent claims to facilitate clarity. Proper clarification and/or correction are required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-9, 12-14, 17-19, 22, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Rusincovitch et al. (#5,866,220) and Yoshikawa et al. (#6,045,646).

Gosselin et al. teach a pressure sensitive adhesive label for indicating information (see Abstract; Col. 2, lines 54-55), the pressure sensitive adhesive label constructed such that it is stuck onto a release sheet with a printed layer before the pressure sensitive adhesive label is used (Col. 2, lines 31-37). The label comprises a release sheet with a release sheet base (Col. 4, lines 44-46), a releasing agent layer provided on one of the surfaces of the release sheet base (Col. 4,

lines 46-47), and a printed layer provided on the releasing agent layer wherein the printed layer has fixed and/or variable information and is formed with any conventional ink or thermal mass transfer material and is made, for example, with resin and/or wax plus dye or pigment and additives and applied via thermal transfer printing ("barrier medium"; Col. 5, lines 36-46; Col. 6, lines 40-43). The label further comprises a label base (Col. 1, lines 55-56; Fig. 1, #21) and a pressure sensitive adhesive layer provided on one of the surface of the label base (Col. 1, lines 56-57; Fig. 1, #26). The printing layer on the release sheet faces the pressure sensitive adhesive layer (see Fig. 1, #s 22 and 26). The pressure sensitive adhesive layer contains a fluorescent dye (Col. 4, lines 59-60). Gosselin et al. further disclose a method of making the pressure sensitive adhesive label wherein a release sheet is prepared with a releasing agent layer and subsequently printed with a printing layer via thermal transfer printing (Col. 5, lines 54-56). A pressure sensitive adhesive label is then prepared and stuck onto the releasing agent layer of the release sheet such that the printed layer faces the pressure sensitive adhesive layer (Col. 5, lines 47-51 and 56-58). Ultimately, the pressure sensitive adhesive label is removed from the release sheet and transferred to a substrate (Col. 5, lines 59-62).

Although Gosselin et al. teach that a wide variety of release liners may be used (Col. 4, lines 44-45), Gosselin et al. explicitly teaches only silicone-based release materials, thereby failing to teach non-silicone containing release materials. Gosselin also fail to teach the use of a metallic layer in the transfer printing layer.

Rusincovitch et al., however, teach a repositionable label substrate comprising a release liner with a transferable ink layer. Rusincovitch et al. teach that anything that can be used as the ink on a printing machine can be used for fabricating the spacers so long as it is not sticky or

tacky upon drying so that the spacers can slide over the application surface (Col. 10, lines 29-49) thereby inclusive of thermo-melting epoxy resin. Rusincovitch et al. also teach a functional equivalence between silicone release coatings and non-silicone based release coatings insofar as teaching that either a silicone coated paper or a PVC or any other appropriate polymer film may be used as the release material (Col. 11, lines 25-32). Rusincovitch et al. teach the above structure for the purpose of providing an adhesive substrate comprising repositionable properties (Col. 1, lines 9-18). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Gosselin et al. and Rusincovitch et al. since both of the aforementioned references are analogous insofar as being directed at release liners comprising printed ink designs intended to be transferred to an adhesive surface upon separation of the adhesive from the release liner.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Gosselin et al. to include a functionally equivalent non-silicone containing release liner in combination with any known transferable ink as taught by Rusincovitch et al. in order to provide an adhesive substrate comprising repositionable properties.

With regards to the teachings of Yoshikawa et al., Yoshikawa et al. also teach a transfer sheet comprising a non-silicone based release liner (Fig. 1, #1, Fig. 5(c), #1) wherein the non-silicone based release liner is made of an olefinic thermoplastic elastomer in combination with a polyethylene resin (Col. 4, lines 14-24). Yoshikawa et al. also teach the use of a transferable printing layer wherein the ink of the printing layer is selected from epoxy resins and may include pigment, a curing agent, and various additives (Col. 7, lines 24-42), and may further include a

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thin metal layer (Col. 8, lines 6-20). Yoshikawa et al. teach the above combination for the purpose of providing a transfer sheet that exhibits excellent properties when applied to non-planar surfaces (see Abstract; Col. 10, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Gosselin et al. and Yoshikawa et al. since both of the aforementioned references are analogous insofar as being directed at release liners comprising printed ink designs intended to be transferred to an end product.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Gosselin et al. to include a release material comprising olefinic thermoplastic elastomer in combination with a polyethylene resin as well as a printed ink layer comprising a metallic layer as taught by Yoshikawa et al. in order to provide a transfer sheet that exhibits excellent properties when applied to non-planar surfaces.

7. Claims 10-11, 15-16, 20-21, and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gosselin et al. (#5,885,677) in view of Rusincovitch et al. (#5,866,220) and Yoshikawa et al. (#6,045,646), and further in view of Higgins (#5,932,352).

Gosselin et al., Rusincovitch et al., and Yoshikawa et al. teach a pressure sensitive adhesive label as detailed above. The aforementioned prior art is silent as to whether the label base is formed of transparent or non-transparent material. It is notoriously well known in the art, however, to select either a transparent or non-transparent material for the label base depending on the desired end product as evidenced by Higgins (Col. 3, lines 21-54). Thus, depending on the desired end product, it would have been obvious to have modified the aforementioned prior art to include either a transparent or non-transparent base. Furthermore, even in the absence of

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the teachings of Higgins, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have selected either a transparent or non-transparent base material in the aforementioned prior art since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious optimization absent demonstration of unexpected results. *In re Leshin*, 125 USPQ 416.

Response to Arguments

8. Applicant's arguments with respect to claims 6-29 have been considered but are moot in view of the new ground(s) of rejection.

The Examiner does note, however, that the Applicant's analysis of the teachings of Gosselin et al. is respectfully disagreed with. The Applicant contends that the barrier medium refers to a compound capable of blocking the migration or diffusion of an additive from the adhesive layer to a substrate and that the pigment or dye is contained in the adhesive layer rather than in a thermal transfer layer of a release sheet. Gosselin et al., however, explicitly state in Col. 5, lines 36-46, that the barrier medium preferably is a conventional ink or thermal mass transfer material and that it may be, for example, of resin and/or wax plus dye or pigment and additives. Therefore, the barrier material comprises the pigment or dye and is first applied to the release liner prior to being transferred to the adhesive as evidenced on Col. 6, lines 40-43.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.


BPE 10/31/03


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/3/03